



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,785	08/25/2006	Yasunori Minakawa	0760-0357PUS1	1126

2292 7590 01/05/2012
BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

YAKOVLEVA, GALINA M

ART UNIT	PAPER NUMBER
----------	--------------

1641

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

01/05/2012

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/590,785	Applicant(s) MINAKAWA ET AL.
	Examiner GALINA YAKOVLEVA	Art Unit 1641

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12/23/2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 07 December 2011. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 10-14 and 21-30.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement(s)*. (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/SHAFIQL HAQ/
Primary Examiner, Art Unit 1641

Continuation of 3. NOTE: Applicant's amendment of Claim 10 has not overcome the rejection of Claims 10-14 and 21-30 under 35 U.S.C. 112, second paragraph. Deleting recitation "for inhibiting decrease in measured values in immunoassays" from the Claim 10's preamble does not clarify the scope of the claimed invention with regard to the use of an agent that inhibits decrease in measured values in immunoagglutination immunoassays. Based on the claim language, it appears that mixing a test sample with an ionic surfactant constitutes an improvement over the known in the art immunoagglutination immunoassays.

Continuation of 5. Applicant's reply has overcome the following rejection(s): The rejection of Claims 11-14 and 21-30 under 35 U.S.C. 102(b) as being anticipated by Moghaddam et al., U.S. Patent 5,972,718, issued on October 26, 1999, is withdrawn in view of Applicant's argument. However, the 102(b) rejection of Claim 10 is maintained for the reasons set forth in the Final Office Action because the broad language of Claim 10 encompasses the embodiment(s) taught by the Moghaddam et al. reference.

Continuation of 11. does NOT place the application in condition for allowance because: (1) The 102(b) rejection of Claim 10 is maintained for the reasons set forth in the Final Office Action. (2) The rejection of Claims 10-14 and 21-30 under 35 U.S.C. 103(a) as being unpatentable over Mitsuhiro et al. JP 09-304384 in view of either Wada et al., WO 2004/092733, filed on April 4, 2004; published on October 28, 2004 or Senn et al., WO 91/10747, published on July 25, 1991, each taken separately, is maintained. Applicant argues that Mitsuhiro et al. do not teach an ionic surfactant of the present invention. However, as indicated in the previous Office Action, Mitsuhiro et al. teach the use of co-polymers of styrene. It is noted that sodium polystyrene sulfonate was employed by Applicant in Example C of the Declaration under 37 CFR 1.132 filed 04/06/2011. In addition, both Wada et al. and Senn et al. teach the use of polymers in which a hydrophobic cyclic monomer(s) having an ionic functional group(s) is(are) polymerized, which polymers reduce the sample constituent interference. As indicated in the previous Office Action, in paragraph [0011], Mitsuhiro et al. teach inhibiting a nonspecific ligation reaction in an antigen-antibody reaction in immunoassays including a latex agglutination assay. Furthermore, in paragraph [0014], Mitsuhiro et al. teach contacting sensitization particulates and a sample and adding a sulfonated polymer to prevent a nonspecific binding. Although Mitsuhiro et al. do not expressly teach mixing a test sample with an ionic surfactant as the required first step of an immunoagglutination immunoassay, according to MPEP 2144.04 (C), selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results. (Ex parte Rubin, 128 USPQ 440 (Bd. App. 1959) (Prior art reference disclosing a process of making a laminated sheet wherein a base sheet is first coated with a metallic film and thereafter impregnated with a thermosetting material was held to render prima facie obvious claims directed to a process of making a laminated sheet by reversing the order of the prior art process steps.). See also In re Burhans, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results); In re Gibson, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (Selection of any order of mixing ingredients is prima facie obvious.).